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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/798,711

03/10/2004

Robert W. Driscoll

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EXAMINER

DUFFY, DAVID W

ART UNIT

PAPER NUMBER

3714

MAIL DATE

DELIVERY MODE

07/10/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/798,711

Applicant(s)

DRISCOLL ET AL.

Examiner

David W. Duffy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) 12-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 19-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>03/22/2004</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-11 and 19-24, drawn to an electronic toy and method of using the toy in a location aware environment, classified in class 446, subclass 297.
 - II. Claims 12-18, drawn to a method of customizing the audio content of a toy, classified in class 446, subclass 297.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are directed to related processes. The related inventions are distinct if the (1) the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect; (2) the inventions do not overlap in scope, i.e., are mutually exclusive; and (3) the inventions as claimed are not obvious variants. See MPEP § 806.05(j). In the instant case, the inventions as claimed are not obvious variants as the process of personalizing a toy would be usable on many other toys with data storage and sound producing means than the toy of group I. Furthermore, the inventions as claimed do not encompass overlapping subject matter and there is nothing of record to show them to be obvious variants.
3. Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required

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because the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Joe Foster on May 14, 2007 a provisional election was made without traverse to prosecute the invention of group I, claims 1-11 and 19-24. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-18 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Objections

6. Claim 1 is objected to because of the following informalities: The claim cites the limitation "the walking character" which is not the same as "a roving character". For consistency, the terms should be the same if they are intended to be the same character. For the purposes of examination, examiner is assuming that the two are the same. Appropriate correction is required.

7. Claim 6 is objected to because of the following informalities: The limitation "the plurality of infrared signal transmitters" which is not the same as "a plurality of wireless signal transmitters". Examiner is assuming applicant intended to use wireless for both limitations and is examining as such. Appropriate correction is required.

8. Claims 9 and 19 are objected to because of the following informalities: "an wireless signal" is improper, suggested correction is "a wireless signal". Appropriate correction is required.

9. Claim 19 is objected to because of the following informalities: "a electric system" is improper, suggested correction is "an electric system". The limitation "the interactive character" has insufficient antecedent basis in the claim. Suggested correction is "an interactive character". Appropriate correction is required.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1-11 and 19-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabai et al. (US 6352478).

12. In regards to claim 1, Gabai discloses a system that has a number of fanciful toy figures with wireless communication systems (48:30-37) where the toy figures include freely mobile characters and a portable owl doll for users to carry (49:6-15 and 49:19-28) where the mobile character transmits information identifying the character (48:66-49:5) and information is received by the other figures (50:47-49). Gabai further discloses that the figures have the ability to direct users to facilities in the theme park (56:34-39 and 56:65-57:9) as well as to direct them to the location of other users in the park (53:27-54:14). Gabai seems to lack in explicitly stating that the portable toy would

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be able to notify the user that a mobile character is nearby. However, in light of the other directional and tracking abilities of the system and the fact that the system is based around sending users to see multiple figures in a game, it would be obvious to also allow the system to direct users from one figure to another to prevent the users from getting lost or to provide tips during the game.

13. In regards to claims 2 and 3, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

14. In regards to claim 4, Gabai discloses that each figure or node has an ID (figure 43A, element 2850).

15. In regards to claim 5, Gabai discloses that the portable owl figure has memory (figure 71, element 4030 which is related to figure 6 with description 35:31-32), but seems to lack in explicitly stating the storage of received signals in the memory.

However, examiner takes OFFICIAL NOTICE that is notoriously well known in the art of computing to cache or store data locally in memory for data processing and would have been an obvious modification to make to reduce the amount of data sent to the remote device.

16. In regards to claim 6, Gabai discloses a system with a number of wireless signal transmitters at various locations throughout a theme park environment (48:66-49:5), that has a number of fanciful toy figures with wireless communication systems (48:30-37) where the toy figures include freely mobile characters and a portable owl doll for users to carry (49:6-15 and 49:19-28) where the mobile character transmits information identifying the character (48:66-49:5) and information is received by the other figures

(50:47-49). Gabai further discloses that the figures have the ability to direct users to facilities in the theme park (56:34-39 and 56:65-57:9) as well as to direct them to the location of other users in the park (53:27-54:14). Gabai seems to lack in explicitly stating that the portable toy would be able to notify the user that a mobile character is nearby. However, in light of the other directional and tracking abilities of the system and the fact that the system is based around sending users to see multiple figures in a game, it would be obvious to also allow the system to direct users from one figure to another to prevent the users from getting lost or to provide tips during the game.

17. In regards to claims 7 and 8, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

18. In regards to claim 9, Gabai discloses a system that has a number of fanciful toy figures with wireless communication systems (48:30-37) and memory (figures 71 and 74, element 4030 and 4270 respectively, which are related to figure 6 with description 35:31-32), where the figures are able to receive signals and trigger playback of preprogrammed data related to received signals (instructs the child to stay put in response to being informed that the parent is searching for the child, 53:27-54:14) where the toy figures include freely mobile characters and a portable owl doll for users to carry (49:6-15 and 49:19-28) where the mobile character transmits information identifying the character (48:66-49:5) and information is received by the other figures (50:47-49). Gabai further discloses that the figures have the ability to direct users to facilities in the theme park (56:34-39 and 56:65-57:9) as well as to direct them to the location of other users in the park (53:27-54:14). Gabai seems to lack in explicitly

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stating that the portable toy would be able to notify the user that a mobile character is nearby. However, in light of the other directional and tracking abilities of the system and the fact that the system is based around sending users to see multiple figures in a game, it would be obvious to also allow the system to direct users from one figure to another to prevent the users from getting lost or to provide tips during the game.

19. In regards to claims 10 and 11, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

20. In regards to claim 19, Gabai discloses a figure with wireless communication equipment (48:30-37) that receives information from a plurality of wireless transmitters in a surrounding environment that generate signals representing the location of objects and characters in the environment (48:66-49:5), memory (figures 71 and 74, element 4030 and 4270 respectively, which are related to figure 6 with description 35:31-32) preprogrammed with data related to location (56:34-39 and 56:65-57:9). Gabai further discloses the storage of data related to the events of a user in the park (51:63-52:25). While seemingly lacking the explicit mention of the data being stored on any of the interactive devices, it would be obvious to store data locally on a device as well to reduce problems stemming from communication interruptions. Gabai further discloses the communicating with the user based on the user's event data (figures 52-57).

21. In regards to claim 20, the user's name is stored in memory (52:37-41).

22. In regards to claim 21, the toy addresses the user using the name from memory (figure 46A, element 2810).

23. In regards to claims 22 and 23, Gabai discloses the use of infrared or radio frequency signals (51:15-24).

24. In regards to claim 24, each object, location or character corresponds with a wireless signal transmitter (49:16-18).

25. In regards to claims 25-27, Gabai discloses that the toys may produce sound effects, music and speech (7:12-19 and 7:31-34).

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6000987 to Belin et al., US 6012961 to Sharpe et al. and US 6022273 to Gabai et al. all directed to electronically configurable toys. US 6110000 to Ting directed to communicating toys. US 6319010 to Kikinis directed to interactive dolls. US 6380844 to Pelekis directed to a location aware doll. US 6415439 directed to wireless communication systems for interactive toys. US 6497606 to Fong et al. directed to interactive dolls that communicate with each other.

Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the

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claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David W. Duffy whose telephone number is (571) 272-1574. The examiner can normally be reached on M-F 0800-1630.

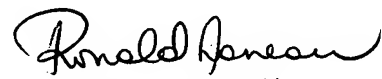
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert E. Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DWD




RONALD LANEAU
PRIMARY EXAMINER

7/2/07